

REMARKS

The present Amendment is in response to the Examiner's Office Action mailed December 14, 2006. Claims 1-12 and 18-23 are cancelled. Claims 13-17 and 24-30 are now pending in view of the above amendments.

Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, Applicants request that the Examiner carefully review any references discussed below to ensure that Applicants' understanding and discussion of the references, if any, is consistent with the Examiner's understanding.

I. PRIOR ART REJECTIONS

A. Rejection Under 35 U.S.C. § 103

The Examiner rejects claims 13-17 and 24-30 under 35 U.S.C. § 103 as being unpatentable over *Woktunik* (U.S. Patent No. 6,211,978) in view of *Hoak* (U.S. Patent No. 5,712,936). The Applicant respectfully traverses the rejection for lack of motivation for the proposed combination.

According to the applicable statute, a claimed invention is unpatentable for obviousness if the differences between it and the prior art "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103(a) (2005); *Graham v. John Deere Co.*, 383 U.S. 1, 14 (1966); MPEP 2142. Obviousness is a legal question based on underlying factual determinations including: (1) the scope and content of the prior art, including what that prior art teaches explicitly and inherently; (2) the level of ordinary skill in the prior art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness. *Graham*, 383 U.S. at 17-18; *In*

re Dembiczak, 175 F.3d 994, 998 (Fed. Cir. 1999). It is the initial burden of the PTO to demonstrate a *prima facie* case of obviousness. If the PTO does not set forth a *prima facie* case of obviousness, the applicant is under no obligation to submit evidence of nonobviousness. MPEP 2142 (emphasis added).

According to MPEP section 2143:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

(Emphasis added).

The Examiner admits on page 3 of the Office Action, that *Woktunik* fails to teach a second optical fiber in optical communication with each of the second transceiver and the third transceiver. However, the Examiner alleges that *Woktunik* suggests in column 8, lines 45-47 “a second optical fiber in optical communication with each of the second transceiver and the third transceiver.” The Applicant respectfully disagrees that column 8, lines 45-47 of *Woktunik* suggests such a configuration. Rather, *Woktunik* clearly teaches away from communication over multiple optical fibers.

Rather, column 8, lines 45-47 of *Woktunik* teach the following, “For example, the single optical fiber 18 can be provided by a single fiber of a fiber optic cable having multiple fibers, or having only a single fiber.” (Emphasis added). This portion of *Woktunik* clearly does not suggest a second optical fiber in optical communication as alleged. Rather, this portion further reinforces the entire teachings of *Woktunik* related to communication over a single fiber.

In fact, to suggest that *Woktunik* teaches communication over a second fiber ignores the purpose and teachings of *Woktunik*. *Woktunik* relates to “bidirectional transmission of two or more modulated light signals over the same fiber optic fiber at the same time.” FIELD OF THE INVENTION. Thus, to modify *Woktunik* for communication over a second optical fiber entirely ignores the teachings of *Woktunik*. As such, the Applicants respectfully request that the rejection of claims 13-17 and 24-30 be withdrawn.

Moreover, the Examiner has not identified how *Woktunik* could be combined with the teachings of *Hoak* to arrive at the claimed invention with a reasonable expectation of success or without the benefit of the Applicant's specification and hindsight. The Examiner has simply used the Applicant's claims as a blueprint to pick and choose only portions of each element without considering the teachings of each reference as a whole. It is error to reconstruct the Applicant's claimed invention from the prior art by using the claim as a "blueprint." When prior art references require selective combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight obtained from the invention itself. *Interconnect Planning Corp v. Feil*, 774 F.2d 1132 (Fed. Cir. 1985).

Rather, the Examiner must supply concrete evidence of motivation rather than a conclusory statement that it would have been obvious to increase the number of wavelength. The final step of the obviousness inquiry requires that concrete evidence of motivation for the missing elements be clearly set forth. "[The Patent Office] may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis." *In re Warner*, 154, USPQ 173, 178 (CCPA 1967). Missing from the combination of *Wojunik* and *Hoak* is the "logical reason apparent from positive, concrete evidence of record" (*In re Regel*, 188 USPQ 136, 139 n.5 (CCPA 1975)) why one of ordinary skill in the art would have been motivated to communicate over two optical fibers where Wojunik includes express teachings to the contrary. The PTO cannot simply make conclusions based on its own understanding or experience – or on its allegation of what would be basic knowledge or common sense. Rather, the PTO must point to some concrete evidence in the record in support of the findings. *In re Zurko*, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001).

Thus, the Applicant respectfully traverses the assertion that one of ordinary skill in the art would be motivated to modify *Wojunik* in a manner that is in direct contrast to the teachings of *Wojunik*. Thus, the Applicant respectfully requests that the rejection of claims 13-17 and 24-30 be withdrawn for lack of motivation for the proposed combination of references.

CONCLUSION

In view of the foregoing, Applicants believe the claims as amended are in allowable form. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, or which may be overcome by an Examiner's Amendment, the Examiner is requested to contact the undersigned attorney.

Dated this 16th day of April, 2007.

Respectfully submitted,

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